



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,161	03/19/2004	Mark W. Kimberlin	D-3054	7384

33197 7590 11/23/2004

STOUT, UXA, BUYAN & MULLINS LLP
4 VENTURE, SUITE 300
IRVINE, CA 92618

EXAMINER

SINGH, SUNIL

ART UNIT PAPER NUMBER

3673

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/805,161

Applicant(s)

KIMBERLIN

Examiner

Sunil Singh

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/12/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6 and 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 ends with "porous element." "porous element."

Claims 13 and 16, "a matrix" is recited and "a fluid matrix" is recited; it appears as if they are the same and therefore, should be related.

Claim 13 line 1, "a surface" is recited; at line 3, "a surface" is recited; it appears that they are the same, therefore they should be related.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 6-7, 9,11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim (US 5662724).

Kim discloses a system for stabilizing a surface (1,2,4) prone to soil erosion, the system comprising: a porous element (3) disposed on a surface to be stabilized; and a fluid matrix material (see abstract, col. 1 lines 40+ thru col. 3 line 40) incorporated within the

Art Unit: 3673

porous element; the system being made by anchoring (5,6) the porous element to the surface and thereafter injecting the fluid matrix material (see col. 4 line 5+) into the porous element and thereafter allowing the fluid matrix material to set within openings defined within the porous element. The porous element is a cellular matting (see Figs. 4a,b). The porous element comprises a netting material (col. 3 line 50+) comprises a netting material. The porous element comprising a reinforced fiber matting (8,9).

5. Claims 1-3, 6-7, 9,11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese document (60-30723).

Japanese document '723 discloses a system for stabilizing a surface (see Fig. 1) prone to soil erosion, the system comprising: a porous element (3) disposed on a surface to be stabilized; and a fluid matrix material (5,7) incorporated within the porous element; the system being made by anchoring (4) the porous element to the surface and thereafter injecting the fluid matrix material (see abstract) into the porous element and thereafter allowing the fluid matrix material to set within openings defined within the porous element. The porous element is a cellular matting (see abstract, Fig. 3b). The porous element comprises a netting material (see abstract, Fig. 3b) comprises a netting material. The porous element comprising a reinforced fiber matting (see abstract, Fig. 3b).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3673

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. ~~Claims 4-5, 8, 10, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable~~
over Kim '724 in view of applicant's admission of prior art.

(Re claims 4,5), Kim discloses the invention substantially as claimed. As a matter of fact, Kim teaches to deposit the flowable material with seeds mixed therein (see col. 4 line 15+) using moderately sized construction equipment (see col. 1 line 40+).

However, Kim is silent about injecting the flowable material into the porous element using conventional seeding apparatus. As admitted by applicant in claim 5 itself and page 5 of his specification seeding apparatus are conventional. Therefore, it would have been considered obvious to one of ordinary skill in the art to modify Kim by injecting his flowable material using a conventional seeding apparatus as taught by applicant to be prior art since such a modification is an obvious design choice. Such a modification allows for the planting step to be combined with the flowable material depositing step.

(Re claim 10), Kim discloses the invention substantially as claimed. However, Kim is silent about the porous element comprising a three-dimensional, cellular matting.

Applicant admits that three-dimensional cellular matting is well known and old in the art (see page 8 of specification). It would have been considered obvious to one of ordinary skill in the art to modify Kim by substituting the three-dimensional cellular matting as taught by applicant to be prior art for the porous element disclosed by Kim since such a modification is an obvious design choice. Such a modification provides a porous element that would not easily rip when applying the anchoring means.

Art Unit: 3673

(Re claims 8, 16), Kim discloses the invention substantially as claimed. However, Kim is silent about the matrix material comprising a mixture of fibers bonded with a polymer material. Applicant admits it is well known to control erosion by spraying a mixture of fibers bonded with a polymer material (see specification, page 2, page 3, in particular reference to US patents 5459181 and 5942029, page 9). It would have been considered obvious to one of ordinary skill in the art to modify Kim by substituting the flowable material as taught by applicant to be prior art for the flowable material disclosed by Kim since such a modification is an obvious design choice. Such a modification would reduce foul odor that can be caused by the sewage sediment.

8. Claims 4-5, 8, 10, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese document '723 in view of applicant's admission of prior art.

(Re claims 4,5), Japanese document '723 discloses the invention substantially as claimed. As a matter of fact, Japanese document teaches to deposit the flowable material with seeds mixed therein (see abstract) using moderately sized construction equipment (see abstract, Fig. 3b). However, Japanese document '723 is silent about injecting the flowable material into the porous element using conventional seeding apparatus. As admitted by applicant in claim 5 itself and page 5 of his specification seeding apparatus are conventional. Therefore, it would have been considered obvious to one of ordinary skill in the art to modify Japanese document by injecting his flowable material using a conventional seeding apparatus as taught by applicant to be prior art since such a modification is an obvious design choice. Such a modification allows for the planting step to be combined with the flowable material depositing step.

Art Unit: 3673

(Re claim 10), Japanese document discloses the invention substantially as claimed.

However, Japanese document is silent about the porous element comprising a three-

dimensional, cellular matting. Applicant admits that three-dimensional cellular matting is well known and old in the art (see page 8 of specification). It would have been considered obvious to one of ordinary skill in the art to modify Japanese document by substituting the three-dimensional cellular matting as taught by applicant to be prior art for the porous element disclosed by Japanese document since such a modification is an obvious design choice. Such a modification provides a porous element that would not easily rip when applying the anchoring means.

(Re claims 8, 16), Japanese document discloses the invention substantially as claimed.

However, Japanese document is silent about the matrix material comprising a mixture of fibers bonded with a polymer material. Applicant admits it is well known to control erosion by spraying a mixture of fibers bonded with a polymer material (see specification, page 2, page 3, in particular reference to US patents 5459181 and 5942029, page 9). It would have been considered obvious to one of ordinary skill in the art to modify Japanese document by substituting the flowable material as taught by applicant to be prior art for the flowable material disclosed by Japanese document since such a modification is an obvious design choice.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday 8:30 AM-5:00 PM.

Art Unit: 3673

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sunil Singh
Primary Examiner
Art Unit 3673



SS
SS

11/15/04